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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,490	09/12/2000	Tadahiro Aihara	04329.2392	6306

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EXAMINER
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FLANDERS, ANDREW C

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/660,490

Applicant(s)

AIHARA ET AL.

Examiner

Andrew C. Flanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 16-29 and 32 is/are rejected.
- 7) ☒ Claim(s) 14, 15, 30 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

or

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1 – 4, 17 – 20 and 33 - 34** are rejected under 35 U.S.C. 102(b) as being anticipated by Murray (U.S. 5,699,089).

Regarding **Claims 1 and 17**, Murray discloses:

means for requesting content from an external device (i.e. retrieving voice mail messages, email messages, fax messages and the like for the user; col. 8 lines 35 – 38);

means for recording the content supplied from the external device (i.e. it is next determined whether the SPO is an object which can be recorded; col. 9 lines 21 – 22; if the object can be recorded the record indicator is enabled and the software is

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configured so that user selection of the record indicator results in initiation of a recording procedure; col. 9 lines 26 – 32);

means for reproducing the content (i.e. play button pressed; Fig. 6F);

means for determining whether or not said reproducing means performs a reproduction when a recording command is issued (i.e. Fig. 6G element 6148);

means for disabling said reproducing means and enabling said recording means when said determining means determines that said reproducing means performs the reproduction when the recording command is issued (i.e. Fig. 6G elements 6148 and 6058).

Regarding **Claims 2 and 18**, in addition to the elements stated above regarding claims 1 and 17, Murray further discloses if the system is not currently playing to advance to the recording step (Fig. 6G element 6148 and 6150) (i.e. means for enabling said recording means when said determining means determines that said reproducing means does not perform reproduction).

Regarding **Claim 3 and 19**, in addition to the elements stated above regarding claims 1 and 17, Murray further discloses determining whether the system is currently recording when the record button is pressed (Fig. 6G element 6140), (i.e. second determining means for determining whether or not said recording means is turned on when the recording command is issued) and if not, the system eventually advances to step 6150 where the system begins recording (Fig. 6G) (i.e. means for turning on said

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recording means when said second determining means determines that recording means is not turned on).

Regarding **Claim 4 and 20**, in addition to the elements stated above regarding claims 1 and 17, Murray further discloses when the record button is pressed they system completes the request and then waits for the next event (Fig. 6B elements 6042, 6056 and 6030) and a play button for playing back data as the next event (Fig. 6B element 6040) (i.e. means for restarting interrupted reproduction after recording is completed).

Regarding **Claim 33**, Murray discloses recording (Fig 6G) (i.e. means for recording a content supplied from an external device), playing (Fig. 6G) (i.e. means for reproducing the content), determining if a telephone connection is established (Fig. 6G) (i.e. means for determining whether or not the apparatus is connected to the external device); and stopping playback if a recording command is issued and recording if the telephone connection is established (Fig. 6g elements 6148, 6127, and 6150) (i.e. means for disabling the reproducing means to stop reproduction of the content and enabling the recording means to start recording of a new content when said determining means determines that the apparatus is connected to the external device)

Regarding **Claim 34**, in addition to the elements stated above regarding claim 33, Murray further discloses when the record button is pressed they system completes

the request and then waits for the next event (Fig. 6B elements 6042, 6056 and 6030) and a play button for playing back data as the next event (Fig. 6B element 6040) (i.e. means for enabling the reproducing mode to restart reproduction after the recording of the new content is completed).

**Claims 5 – 8 and 21 – 24** are rejected under 35 U.S.C. 102(e) as being anticipated by Moon (U.S. Patent 6,629,000).

Regarding **Claims 5 and 21**, Moon discloses a transmitter/receiver that receives data from a PC (Fig. 2 element 800) (i.e. means for recording a content supplied from an external device), headphones and speakers (Fig. 2 element 705) (i.e. means for reproducing the content), determining if there is a connection with the external device (Fig. 3a element 1800) (i.e. means for determining whether or not the apparatus is connected to the external device), an information selector portion (fig. 2 element 300) (i.e. means for selectively setting an operation mode) and the information selector contains predetermined keys operated by the user, and outputs electrical signals according to the user selections to control the supply of power, extract data for reproduction, control various functions related to the reproducing of data and transmit and receive data (col. 3 lines 59 – 65) (i.e. means for controlling said recording means and said reproducing means in accordance with the operation mode set by said setting

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means when said determine means determines that the apparatus is connected to the external device).

Regarding **Claims 6 and 22**, in addition to the elements stated above regarding claims 5 and 21, Moon discloses connecting to an external device and not communicating with that device until sound data is not being reproduced (Fig. 3a elements 1700 and 1800, Fig 3b element 1420, Fig 3e, and Fig 3f) (i.e. wherein said setting means sets one of a first mode, a second mode, a third mode, and a fourth mode; and the first mode is set, reproduction is continued if the apparatus is connected to the external apparatus during reproduction).

Regarding **Claims 7 and 23**, in addition to the elements stated above regarding claims 5 and 21, Moon discloses a reproduction signal (Fig. 3b element 1420) (i.e. wherein said setting means comprises an interface device for manually setting the operation mode).

Regarding **Claims 8 and 24**, in addition to the elements stated above regarding claims 5 and 21, Moon discloses determining whether the device is connected to an external system (Fig. 3a element 1800). In order to determine whether the system is connected it is inherent there must be some sort of communication from the external system to the device whether it be a signal or an impedance detection it is supplied by

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the external system (i.e. wherein said setting means comprises means for receiving a mode setting command from the external device).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 9 – 13, 16 and 25 – 29, 32** rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows (U.S. Patent 6,377,530) in view of Maehashi (U.S. Patent 6,587,641).

Regarding **Claims 9 and 25**, Burrows discloses

means for recording a content supplied from an external device (i.e. a computer jack; Fig. 1 element 132)

means for reproducing the content the reproducing means buffering content data before reproduction (i.e. a compressed audio data buffer and an audio output jack; Fig. 1 elements 108 and 130).

Burrows does not explicitly disclose means for detecting that a sufficient amount of the content data is buffered when a recording command is issued during reproduction; and



means for enabling said recording means when said detecting means detects that the sufficient amount of the content data is buffered.

Maehashi discloses

Writing limiting means constantly monitors the second predicted consumption duration worked out by second consumption duration predicting means, when the second predicted consumption is less than the second threshold value, a write inhibit flag is erected to bar writing means from writing; col. 7 lines 32 – 38; and in the case the second predicted consumption duration is larger than the second threshold value, the write inhibit flag is lifted to lift the ban on writing; col. 7 lines 48 – 51.

Applying this disc access teaching to the Burrows reference would allow Burrows to record during playback when a recording command was issued (i.e. connecting the device to the computer via the computer jack; Fig. 1). The combination would read upon the limitation of means for detecting that a sufficient amount of the content data is buffered when a recording command is issued during reproduction; and

means for enabling said recording means when said detecting means detects that the sufficient amount of the content data is buffered.

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Maehashi's disk recording and reproducing technique to the player disclosed by Burrows. One would have been motivated to do so to prevent interruption during reading or writing; See Maehashi col. 1 lines 5 – 60.

Regarding **Claims 10 and 26**, in addition to the elements stated above regarding claims 9 and 25, the combination of Burrows in view of Maehashi further discloses:

means for disabling said recording means when said detecting means does not detect that the sufficient amount of the content data is not buffered (i.e. when the second predicted consumption is less than the second threshold value, a write inhibit flag is erected to bar writing means from writing; col. 7 lines 32 – 38 in Maehashi).

Regarding **Claim 11 and 27**, in addition to the elements stated above regarding claims 10 and 26, the combination of Burrows in view of Maehashi further discloses:

means for keeping reproduction of said reproducing means when said detecting means detects that the sufficient amount of the content data is buffered (i.e. video-audio data being read is kept real-time by temporarily restricting the writing of video-audio data in the storage device on the basis of the second predicted consumption duration while the data is being read; col. 8 lines 1 – 5; and in the case the second predicted consumption duration is larger than the second threshold value, the write inhibit flag is lifted to lift the ban on writing; col. 7 lines 48 – 51 in Maehashi).

Regarding **Claims 12 and 28**, in addition to the elements stated above regarding claims 10 and 26, the combination of Burrows in view of Maehashi further discloses:

means for starting said recording means when said detecting means detects that the sufficient amount of the content data is buffered (i.e. and in the case the second

predicted consumption duration is larger than the second threshold value, the write inhibit flag is lifted to lift the ban on writing; col. 7 lines 48 – 51 in Maehashi).

Regarding **Claims 13 and 29**, in addition to the elements stated above regarding claims 9 and 25, the combination of Burrows in view of Maehashi further discloses:

means for setting an operation mode (i.e. burrows discloses a user interface with various settings; Fig. 1 element 116);

and means for controlling said reproducing means in accordance with the operation mode when said detecting means detects that the sufficient amount of the content data is not buffered (i.e. when the play command is issued in Burrows, Maehashi discloses that video-audio data being read is kept real-time by temporarily restricting the writing of video-audio data in the storage device on the basis of the second predicted consumption duration while the data is being read; col. 8 lines 1 – 5).

The combination does not explicitly disclose means for controlling said recording means in accordance with the operation mode when said detecting means detects that the sufficient amount of the content data is not buffered. However, it is inherent that there must be some means present to allow for a recording. A recording operation must be set in order to start the method disclosed by Maehashi. Thus, in addition to the cited passages stated above, this reads upon the claimed limitation of means for controlling said recording means in accordance with the operation mode when said detecting means detects that the sufficient amount of the content data is not buffered.

Regarding **Claims 16 and 32**, in addition to the elements stated above regarding claims 13 and 29 the combination of Burrows in view of Maehashi further discloses:

wherein said setting means comprises means for receiving a mode setting command from the external device (in addition to the user interface, the host computer when coupled to the system can perform various operations; col. 5 lines 1 – 5)

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 – 4, 17 – 20 and 33 – 34 have been considered but are moot in view of the new ground(s) of rejection necessitated by applicant's amendment.

Applicant's arguments with respect to claims 5 – 8 and 21 - 24 have been fully considered but they are not persuasive.

Applicant primarily asserts that Moon does not teach “means for controlling said recording and said reproducing means in accordance with the operation mode set by setting means when determining means determines that the apparatus is connected to the external device”. More so, Applicant alleges that Examiner has failed to show where Moon teaches means for controlling said recording means... in accordance with the operation mode set by said setting means.

Examiner respectfully disagrees that Moon does not teach this limitation.

Examiner points to Fig. 3a of the Moon reference. As shown in the previous rejection, in Fig. 3a element S1400, Moon's device detects whether key input signals are present. Based upon this detection, the system either proceeds to the S1500 or to 1 of Fig. 3b. If input signals are not detected, the system proceeds to S1800 and a recording operation takes place. If the system does detect input signals, the system goes to Fig. 3b and no recording operation takes place. Thus, depending on whether or not input signals are present, the system controls the recording operation. This in effect reads upon the limitation in question of means for controlling said recording means... in accordance with the operation mode set by said setting means. As such the arguments are not persuasive and the rejection stands.

Applicant's arguments with respect to the rejection(s) of claim(s) 9 – 16 and 25 - 32 under USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Maehashi (U.S. Patent 6,587,641).

#### ***Allowable Subject Matter***

Claims 14, 15, 30 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Claims 14 and 30 teach various modes of operation when a recording and reproducing apparatus is connected to an external device. The closest prior art in the reproduction and recording art [see Moon (U.S. Patent 6,629,000); Burrows (U.S. Patent 6,377,530); Dwyer (U.S. Patent 6,671,567); Pawlowski (U.S. Patent 6,038,199); all of these reference teach connecting a recording/reproducing device to an external device for the purpose of transferring data] teaches of connecting various devices to external devices to transfer data. However, the prior art does not teach the level of detail as disclosed in applicant's dependent claims 14 and 30 nor would it have been obvious to one of ordinary skill in the art at the time of the invention to modify these reference's to operate as applicant's claims 14 and 30 teach.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C. Flanders whose telephone number is (571) 272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (571) 272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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